

REMARKS

Applicant thank the Examiner for the very thorough consideration given the present application.

Claims 1, 5, 6 and 10 are now present in this application. Claims 1 and 6 are independent. Claims 2-4 and 7-9 have been canceled, and claims 1 and 6 have been amended. No new matter is involved.

Reconsideration of this application, as amended, is respectfully requested.

Priority Under 35 U.S.C. § 119

Applicant thanks the Examiner for acknowledging Applicant's claim for foreign priority under 35 U.S.C. § 119, and receipt of the certified priority document.

Rejection Under 35 U.S.C. § 102

Claims 1, 2 and 5 stand rejected under 35 U.S.C. § 102(b) as being clearly anticipated by either Japan 62-201041 (Japan '041) or U.S. Patent 4,491,763 to Imai al. ("Imai"). This rejection is respectfully traversed.

This rejection is moot as claim 1 has been amended to include subject matter similar to that as recited in claim 4.

Claims 1, 2, 5-7 and 10 stand rejected under 35 U.S.C. § 102(e) as being clearly anticipated by either U.S. Patent 6,396,177 to Shin et al. ("Shin") or U.S. Patent 6,339,275 to Katagiri. This rejection is respectfully traversed.

This rejection is also moot as claims 1 and 6 have been amended to include subject matter recited in dependent claims 4 and 9, respectively.

Rejections under 35 U.S.C. § 103

Claims 3, 4, 8 and 7 (sic: 9) stand rejected under 35 U.S.C. § 103(a) as being unpatentable over the applied art in view of (1) U.S. Patent 4,219,752 to Katou or (2) U.S. Patent 4,115,716 to Ogasawala et al. (“Ogasawala”) or (3) U.S. Patent 5,659,216 to Bisantz. This rejection is respectfully traversed.

A complete discussion of the Examiner’s rejection is set forth in the Office Action, and is not being repeated here.

Because the rejection is based on 35 U.S.C. § 103, what is in issue in such a rejection is “the invention as a whole”, not just a few features of the claimed invention. Under 35 U.S.C. § 103, “[a] patent may not be obtained . . . if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains.” The determination under section 103 is whether the claimed invention as a whole would have been obvious to a person of ordinary skill in the art at the time the invention was made. See *In re O’Farrell*, 853 F.2d 894, 902, 7 USPQ2d 1673, 1680 (Fed. Cir. 1988). In determining obviousness, the Examiner must explain what the differences between the claimed invention and the prior art are and provide objective factual evidence to support a conclusion that it would be obvious to one of ordinary skill in the art to achieve the claimed invention, which includes those missing features.

In the second place, in rejecting claims under 35 U.S.C. § 103, it is incumbent on the Examiner to establish a factual basis to support the legal conclusion of obviousness. See, In re Fine, 837 F.2d 1071, 1073, 5 USPQ2d 1596, 1598 (Fed. Cir. 1988). In so doing, the Examiner is expected to make the factual determinations set forth in Graham v. John Deere Co., 383 U.S. 1, 17, 148 USPQ 459, 467 (1966), and to provide a reason why one of ordinary skill in the pertinent art would have been led to modify the prior art or to combine prior art references to arrive at the claimed invention. Such reason must stem from some teaching, suggestion or implication in the prior art as a whole or knowledge generally available to one having ordinary skill in the art. Uniroyal, Inc. v. F-Wiley Corp., 837 F.2d 1044, 1051, 5 USPQ2d 1434, 1438 (Fed. Cir. 1988), cert. denied, 488 U.S. 825 (1988); Ashland Oil, Inc. v. Delta Resins & Refractories, Inc., 776 F.2d 281, 293, 227 USPQ 657, 664 (Fed. Cir. 1985), cert. denied, 475 U.S. 1017 (1986); ACS Hospital Systems, Inc. v. Montefiore Hospital, 732 F.2d 1572, 1577, 221 USPQ 929, 933 (Fed. Cir. 1984). These showings by the Examiner are an essential part of complying with the burden of presenting a *prima facie* case of obviousness. Note, In re Oetiker, 977 F.2d 1443, 1445, 24 USPQ2d 1443, 1444 (Fed. Cir. 1992). The mere fact that the prior art may be modified in the manner suggested by the Examiner does not make the modification obvious unless the prior art suggested the desirability of the modification. In re Fritch, 972 F.2d 1260, 1266, 23 USPQ2d 1780, 1783-84 (Fed. Cir. 1992). To establish *prima facie* obviousness of a claimed invention, all the claim limitations must be suggested or taught by the prior art. In re Royka, 490 F.2d 981, 180 USPQ 580 (CCPA 1970). All words in a claim must be considered in judging the patentability

of that claim against the prior art. In re Wilson, 424 F.2d 1382, 1385, 165 USPQ 494, 496 (CCPA 1970).

A showing of a suggestion, teaching, or motivation to combine the prior art references is an “essential evidentiary component of an obviousness holding.” C.R. Bard, Inc. v. M3 Sys., Inc., 157 F.3d 1340, 1352, 48 USPQ2d 1225, 1232 (Fed. Cir. 1998). This showing must be clear and particular, and broad conclusory statements about the teaching of multiple references, standing alone, are not “evidence.” See In re Dembiczak, 175 F.3d 994 at 1000, 50 USPQ2d 1614 at 1617 (Fed. Cir. 1999).

Moreover, a factual inquiry whether to modify a reference must be based on objective evidence of record, not merely conclusory statements of the Examiner. See, In re Lee, 277 F.3d 1338, 1343, 61 USPQ2d 1430, 1433 (Fed. Cir. 2002).

Initially, Applicant does not understand why the Office Action uses multiple alternative references to serve as multiple separate grounds of rejection which is a direct violation of the Manual of Patent Examination Procedure’s statement that this is improper and should not be done. See, in this regard, MPEP § 706.02. Applicant respectfully requests that the Examiner select the single best one of the four primary applied references and the single best one of the three secondary applied references and apply only one of each in this rejection.

Applicant respectfully submits that it is improper to make twelve different rejections of these claims, as has been done here, requests that the number of rejections be reduced to what is permitted by MPEP § 702.02.

As noted above, subject matter from claim 4 has been added to claim 1 by amendment, and subject matter from claim 9 has been added to claim 6.

Applicant notes that none of the four base primary references, i.e., Japan '041 or Imai or Shin or Katagiri, discloses the claimed invention. Moreover, none of Katou, Ogasawala or Bisantz discloses the claimed combination of features recited in claims 1 or 6, as amended, for reasons discussed below.

Katou's Fig.2, which is relied on in the Office Action, does disclose that its "iron flywheel 1 is formed at the open end with a tying caulking lip 1a" – see col. 2, lines 43-46, but that caulking lip does not have the positively recited features of (1) a rotor having a guide groove located in its topside and provided to leave a predetermined interval from an outside of the stator, the rotor being adapted to rotate when a current is applied to the coil; or (2) a frame having a fixing means extending inward to fit into the guide groove for fixing the rotor wherein the fixing means is built in one body of an inner circumference of the frame.

Ogasawala discloses a holding piece 20 which presses against an annular magnet holding plate 17, but clearly does not disclose or suggest the positively recited features of (1) a rotor having a guide groove located in its topside and provided to leave a predetermined interval from an outside of the stator, the rotor being adapted to rotate when a current is applied to the coil; or (2) a frame having a fixing means extending inward to fit into the guide groove for fixing the rotor wherein the fixing means is built in one body of an inner circumference of the frame.

Bisantz discloses a "rolled edge or lip 20 which extends radially inward from and orthogonal to the circumferential side wall 15" as disclosed in col. 3, lines 26-38, but clearly does

not disclose or suggest the positively recited features of (1) a rotor having a guide groove located in its topside and provided to leave a predetermined interval from an outside of the stator, the rotor being adapted to rotate when a current is applied to the coil; or (2) a frame having a fixing means extending inward to fit into the guide groove for fixing the rotor wherein the fixing means is built in one body of an inner circumference of the frame.

Therefore, even if it were obvious to modify any of the four primary references in view of any of the three secondary references (which has not been demonstrated to be the case by any objective factual evidence) none of the modified versions of the four base references would render obvious the claimed invention.

Moreover, instead of addressing the specific structural features of each base reference and providing objective factual evidence of motivation to modify those features with the features of each of the secondary references, including a need to modify each base reference, the Office Action merely lumps the base references together without addressing why one of ordinary skill in the art would be motivated to modify their structural features other than by providing a broad generic reason, i.e., to reinforce or fortify the frame which is not persuasive because the base references already have fortified or reinforced frames and do not exhibit a need for further fortification or reinforcement.

Accordingly, Applicant respectfully submits that claims 1 and 6, as amended, patentably define over the applied art.

Additional Cited References

Because the remaining references cited by the Examiner have not been utilized to reject the claims, but have merely been cited to show the state of the art, no comment need be made with respect thereto.

Conclusion

All of the stated grounds of rejection have been properly traversed, accommodated, or rendered moot. Applicant therefore respectfully requests that the Examiner reconsider all presently outstanding rejections and that they be withdrawn. It is believed that a full and complete response has been made to the outstanding Office Action, and as such, the present application is in condition for allowance.

If the Examiner believes, for any reason, that personal communication will expedite prosecution of this application, the Examiner is invited to telephone Robert J. Webster, Registration No. 39,538, at (703) 205-8076, in the Washington, D.C. area.

Prompt and favorable consideration of this Amendment is respectfully requested.

Application No.: 10/721,357
Reply to October 5, 2006 Office Action

Attorney Docket No. 0465-1085P
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If necessary, the Commissioner is hereby authorized in this, concurrent, and future replies, to charge payment or credit any overpayment to Deposit Account No. 02-2448 for any additional fees required under 37 C.F.R. §§ 1.16 or 1.17; particularly, extension of time fees.

Date: March 23, 2007

Respectfully submitted,

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